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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,917	05/22/2001	Michael Jarman	708P009508-US(PAR)	8732

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EXAMINER
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BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/862,917

Applicant(s)

JARMAN ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 28 is confusing, because it describes method steps while referring to a system.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-9, 11-12, 14-16, 18, 20-24, 27-28 and 31-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Synesiou et al. (US 5,959,549).

Synesiou et al. teach a system and method for a communal utility metering arrangement, comprising:

As per claims 1, 2, 7 and 31-34,

- a user interface unit capable of accepting a transaction authorization (Fig. 1;

Abstract; column 1, line 30 – column 2, line 62; column 3, line 15 – column 4, line 67);

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- a utility meter provided at a location having an associated location identifier unique to the location, wherein the utility meter is arranged to communicate with the user interface unit, to obtain a transaction authorization, and to transmit an authorization request based on the transaction authorization and location identifier to obtain authorization of the transaction, and wherein said system further comprising a communication unit arranged to communicate with an authorization authority, wherein the utility meter is arranged to submit the authorization request to the communication unit for communication to the authorization authority to obtain authorization of the transaction (Fig. 1; Abstract; column 1, line 30 – column 2, line 62; column 3, line 15 – column 4, line 67).

As per claims 3, 11-12, 22-23 and 27-28, said system and method, wherein the utility meter is arranged to submit utility usage data to the communication unit (Abstract; column 1, line 30 – column 2, line 62; column 5, lines 15-47).

As per claims 4, 6, 14-16, said system and method, comprising a further utility meter provided at the location, wherein said further utility meter is arranged to submit utility usage data to the communication unit (Abstract; column 1, line 30 – column 2, line 62; column 5, lines 15-47).

As per claim 18, said system and method, in which the user interface unit includes a keyboard, wherein the user interface unit is arranged to accept data entered via the keyboard to form at least a part of a transaction authorization (Fig. 4; column 5, lines 15-47).

As per claims 20 and 21, said system and method in which the user interface unit includes a display, wherein the user interface unit is arranged to display on request utility usage data from the utility meter, and wherein the user interface unit is connectable to a computer, wherein the user interface unit, when connected to a computer, is operative to make necessary transaction authorization requests in response to electronic transactions initiated on the computer (column 1, line 30 – column 2, line 62; column 3, line 15 – column 4, line 67).

As per claim 24, said system and method, further comprising a digital cellular transceiver arranged to communicate with the utility meter for transmitting data to, and receiving data, from a remote source (column 3, lines 41-49).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 10, 19 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Synesiou et al.

As per claim 5, Synesiou et al. teach all the limitations of claim 10, including said further utility meter is arranged to submit the utility usage data to the communication unit (column 1, line 30 – column 2, line 62; column 5, lines 15-47).

Synesiou et al. do not specifically teach that said further utility meter is arranged to submit the utility usage data to said utility meter for submission to the communication

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unit. However, Synesiou et al. teach said system and method certainly capable of performing the subsequent function if so programmed. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

As per claim 10, Synesiou et al. teach all the limitations of claim 10, including submitting the authorization requests to a treasury department which includes a computer network with a number of terminals and a database (column 3, lines 26-35). However, Synesiou et al. do not expressly teach that said treasury department includes banking authorities.

It would have been an obvious matter of design choice to modify Synesiou et al. to include submitting the authorization requests to banking authorities, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Synesiou et al. would perform the invention as claimed by the applicant with any type of a user credit authorization entity.

As per claim 19, Synesiou et al. teach all the limitations of claim 19, including that the utility meter includes a memory (column 4, lines 4-67), except that said memory stores a user's banking data. However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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As per claim 25, Synesiou et al. teach all the limitations of claim 25, including that said system comprises a transceiver arranged to communicate with the utility meter (column 3, lines 41-49), except that said transceiver is the communication unit.

It would have been an obvious matter of design choice to modify Synesiou et al. to include that said transceiver is the communication unit, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Synesiou et al. would perform the invention as claimed by the applicant either with or without specifying that said transceiver is the communication unit.

Also, as per claim 25, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include that said transceiver is the communication unit, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Claims 13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Synesiou et al. in view of Littlejohn (US 6,553,353).

As per claims 13 and 17, Synesiou et al. teach all the limitations of claims 13 and 17, including inputting a credit card number into the user interface unit (column 5, lines 48-65). However, Synesiou et al. do not specifically teach that said user interface unit comprises a card reader device or a telephone.

Littlejohn teaches a system and method for advanced metering system enabling regulation and billing of utilities, wherein a customer makes payment assurances via a telephone or a card reader device (Abstract; column 6, lines 45-65).

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It would have been an obvious matter of design choice to modify Synesiou et al. to include that said user interface unit comprises a card reader device or a telephone, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Synesiou et al. would perform the invention as claimed by the applicant with any type of means for payment for the utility.

Claims 26 and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Synesiou et al. in view of Langford (US 5,956,462).

As per claims 26 and 29-30, Synesiou et al. teach all the limitations of claims 26 and 29-30, except for a switching unit controllable by the utility meter for switching one or more appliances on or off when the utility meter receives a signal indicating the availability of cheap-rate energy.

Langford teaches a system and method for domestic electric energy control, comprising a switching means which is, upon receiving energy priority rating signals, used to reduce number of appliances that are turned on (Abstract; column 3, lines 14-34).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Synesiou et al. to include a switching unit controllable by the utility meter for switching one or more appliances on or off when the utility meter receives a signal indicating the availability of cheap-rate energy, because it would reduce the risk that the user would run out of power for the most important appliances.

### ***Conclusion***

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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

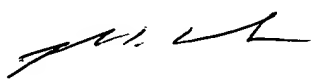
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or faxed to:

**(703) 305-7687** [Official communications; including After Final  
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

IB

  
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